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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/999,730 12/24/97 STAAT

R 7311-24RE

000570 PM82/0724
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103

EXAMINER

MORANO IV, S	
ART UNIT	PAPER NUMBER

3617
DATE MAILED:

07/24/01

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application N .

08/999,730

Examiner

S. Joseph Morano

Applicant(s)

STAAT, ROBERT H.

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-8 is/are allowed.
- 6) ☒ Claim(s) 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 24.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. As set forth in the interview on July 05, 2001 (summary paper #24), the objection to the form of the amendment has been withdrawn and the amendment filed June 12, 2001 has been considered on its merits.

2. In accordance with applicant's request in the amendment filed June 12, 2001, the finality of the previous Office action is hereby withdrawn. Accordingly the amendment filed June 12, 2001 has been entered as a matter of right and treated as a response to the now non-final Office action of March 03, 2001.

Reissue Applications

3. Claims 9-21 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the

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meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, the claims improperly remove limitations that the prosecution history of the parent application indicates were essential to the allowance of the application. The reasons for allowance in the original applicant specifically state that the allowance of the application was because of “the combination ***of all of the features claimed in claim 7***, in particular with the use of two stops on the coupling head for limiting pivotal movement of the coupler knuckle against the spring” (emphasis added). Because the application was allowed based on these limitations, and because applicant did not disagree with the reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered broader coverage outside of the scope of claim 7. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims beyond what the prosecution history indicated as being essential to patentability. It is suggested that the deleted material of claim 7 be reinstated in the independent claims to place the application in condition for allowance and eliminate the recapture.

In claim 9, the limitation of the *drawbar capable of being pivotally mounted within a coupler pocket in the end of a model railroad car* is missing.

In claims 10-15, the limitation of the drawbar *capable of being pivotally mounted within a coupler pocket in the end of a model railroad car* is missing.

In claims 10, 12-15, the limitations of *a leaf spring being formed as an integral part of the first end of the drawbar and extending from the first end of the drawbar* is missing.

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In claim 11, the limitation of the leaf spring *being formed as a integral part of the first end of the drawbar* is missing.

In claims 16-21, the limitation of the *drawbar capable of being pivotally mounted within a coupler pocket in the end of a model railroad car* is missing.

In claims 16, 18-21, the limitations of *a leaf spring being formed as a integral part of the first end of the drawbar and extending from the first end of the drawar* is missing.

In claim 17, the limitation of the leaf spring *being formed as a integral part of the first end of the drawbar* is missing.

Allowable Subject Matter

4. Claims 2-8 are allowed.

Response to Arguments

5. Applicant's arguments filed on June 12, 2001 have been fully considered but are not deemed persuasive.

Specifically, applicant again argues that the recapture rejection was improper because of a lacking in evidence of a clear agreement by the inventor or his attorney with the examiner's statement of reasons for allowance. Applicant states that the examiner's reliance on the failure to comment on the examiner's reasons for allowance is unfounded, as the rule specifically states that failure to comment is not acquiescence as to why the application was allowed. Furthermore, applicant argues

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that the examiner's position is unreasonable and inequitable towards this applicant.

None of these arguments are persuasive for the reasons set forth below.

In response to applicant's first two arguments, it is believed that the evidence of record clearly does show applicant's acceptance of the examiner's reasoning for allowance of the application, and thus applicant's statement in this regard is factually inaccurate. As set forth in paragraph 2 of the Office action mailed 10/31/95 in parent application 08/292,880: "Any comments considered necessary by applicant must be submitted no later than the payment of the Issue Fee...". Because no comments regarding the error in the examiner's reasoning as to why the application was being allowed were considered necessary by applicant, applicant agreed on the record with why *the examiner* was allowing the application. This is not necessary the same as agreeing with the examiner's reasons, as correctly noted in applicant's citation of the rule. Thus, the evidence of record does in fact show that applicant acquiesced to the fact that these were the reasons that *the examiner* was allowing the application, namely the combination of "all of the features claimed in claim 7". While applicant's failure to comment may not constitute agreement with the examiner's reasoning, this is not a catchall preventative to appliance of the recapture doctrine. At the time of allowance, the examiner clearly stated on the record that *the examiner* believed all of the features of claim 7 were necessary for allowance. While applicant's opinion as to the necessity of all of the features may have differed, applicant nonetheless accepted the fact that this is why *the examiner* was allowing the application. The attempt to remove material that *the examiner* deemed critical for patentability is in fact recapture, regardless of applicant's opinion as to the validity of the examiner's reasoning. It should be noted that the examiner's position is consistent with USPTO internal

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guidelines regarding recapture. As it appears that the examiner and applicant are at a genuine impasse regarding this issue, appeal to the Board of Appeals is suggested as the best way to advance prosecution of claims 9-12 other than cancellation

In response to applicant's final argument that the examiner is inequitably treating applicant, and the apparent implication of unfairness and bias, the examiner believes such assertions to be without evidentiary merit, and such assertions are not well taken. The examiner treats all applicants with the same degree of professional fairness, and in fact, the examiner's position on the recapture issue is in accordance with USPTO internal examination guidelines regarding examiner's reasons for allowance and recapture. Thus, the examiner is not going out of his way to unfairly deny applicant broadening rights, but is simply following internal guidance.

For all of the reasons set forth above, the rejection is deemed proper and will not be withdrawn.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication should be directed to S. Joseph Morano at telephone number (703) 308-0230. Supervisory Patent Examiner Morano can normally be reached Monday through Thursday, 7:30am-5:00pm.

Sjm
July 17, 2001

A handwritten signature in black ink, appearing to read 'S. Morano', with a stylized flourish at the end.

S. JOSEPH MORANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600